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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/510,617

04/25/2005

Wenlong Deng

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1639

23363 7590 04/29/2009
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EXAMINER

LEITH, PATRICIA A

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

04/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/510,617	Applicant(s) DENG, WENLONG	
	Examiner Patricia Leith	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 12 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 12 and 19 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 11-16 are pending in the application.

Claims 13, 14 and 16 remain withdrawn from examination on their merits.

Claims 11, 12 and 15 were examined.

The new Oath submitted on 1/29/2009 listing the Inventor's citizenship as 'China' is accepted.

This application is in condition for allowance except for the following formal matters: The specification as amended on 1/29/2009 is still replete with new matter. While it is appreciated that Applicants are merely attempting to amend the specification to remove the idiomatic language and to further clarify the specification, any term or phrase that is substituted for another in the Specification must have originally been present in the original disclosure as filed. If the replacement word or phrase was not found in the original disclosure either explicitly or implicitly, the word or phrase is considered New matter. Examples of new matter introduced into the specification upon entry of the amended specification entered on 1/29/2009 are:

Page 3, line 4, 'low'.

Page 3, line 12, 'damaging.'

Page 3, line 14, 'minimal.'

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Page 3, line 22, 'minimal.'

Page 4, line 18, 'proportional combinations of.'

Page 5, lines 1, 11, 17 and 23, 'proportional combinations of.'

Page 6, lines 4, 12 and 20, 'proportional combinations of.'

Page 7, line 2 'should.'

Page 7, line 3, 'proportional combinations of.'

Page 7, line 14 'proportional combinations of.'

Page 7, line 22 'are prepared based on their proportional combinations and then they'.

Please note that these are merely several examples of the introduction of new matter into the specification, and many more exist. Applicant is asked to thoroughly review the specification and make modifications only which do not depart from the scope of the disclosure as originally filed.

In a telephone conversation with Attorney John Carpenter on 4/23/09, the Examiner suggested that Applicant expressly abandon this case and file a CIP with a new Specification in order to remedy the specification under objection. Alternatively, the Examiner indicated that an Ex Parte Quayle action could be instituted in order to permit Applicant time to file a substitute translated specification of the PCT specification. A phone call to PCT Legal by the Examiner revealed that a new translation of the original

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PCT document would only be entertained via Petition to PCT Legal. This Information was relayed to Applicant . Applicant chose to not file a CIP. Applicant agreed to the changes in the Examiner's amendment therefore the only remaining objectionable matter in this application is the new matter which has been introduced into the specification via amendment on 1/29/2009.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Attorney John Carpenter on 4/23/09.

IN THE CLAIMS:

Claim 12: Line 1, after 'wherein' insert --the weights of each alcoholic extract are as follows:--.

Claim 12, line 5, after '*Cuscuta australis* R. Br.' delete the comma '(,)' and insert -- is --.

Cancel claim 15 and insert the following new claim:

--Claim 19. A pharmaceutical dosage form of a hard capsule, soft capsule, tablet, granule or injectable liquid for treating rheumatism, wherein said dosage form contains a pharmaceutical mixture consisting of an alcoholic extract of:
Tripterygium hypoglaucum (Levl.) Hutch. 1-4 parts by weight of the mixture,
Epimedium brevicornum Maxim. 1-4 parts by weight of the mixture, and
Cuscuta chinensis Lam., or *Cuscuta australis* R. Br., 1-4 parts by weight of the mixture.--.

This application is in condition for allowance except for the above-mentioned objection to the specification, as well as the presence of claims 13-14 and 16 directed to methods for preparing the composition of claim 11 non-elected without traverse. Accordingly, claims 13, 14 and 16 are hereby cancelled. Claims 13-14 and 16 are not

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eligible for rejoinder because none of these claims correspond to a method for making the alcoholic extract of the plants as required for claim 11 as these claims are directed toward alcohol/water extracts and decoctions (water extracts).

Claims 11-12 and 19 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia Leith

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Primary Examiner
Art Unit 1655

/Patricia Leith/
Primary Examiner, Art Unit 1655